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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,674	11/30/2001	Masanori Ishii	215896US0PCT	7867

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EXAMINER

RAYFORD, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/926,674

Applicant(s)

ISHII ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 5-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims and Captioning***

1. Claims 1-18 are pending. Claims 1-2 and 5-18 are withdrawn as non-elected.
2. Claims 13-18 were added on 30 November 2001 via preliminary amendment. As acknowledged by applicants in the 23 September 2004 response, claims 13-16 and 18 belong to non-elected Group V. Claim 17 belongs to non-elected Group VI. See the restriction requirement dated 09 April 2001.
3. The examiner notes that the amendment of 23 September 2004 could have been held non-responsive because the non-elected claims were not properly captioned. But in the interest of compact prosecution, the examiner will forego such a holding and treat claims 1-2 and 5-18 as if they were properly captioned as "withdrawn".
4. It is requested that application properly caption all claims in their next response.

### ***Election/Restrictions***

5. This application contains claims 1-2 and 5-18, drawn to inventions nonelected with traverse in the response dated 05 May 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
6. The restriction requirement is made FINAL.
7. The examiner will now respond to the arguments concerning the restriction requirement advanced on page 2 of the 05 May 2004 response and on page 9 of the 23 September 2004 response.

On 05 May 2004, applicants argued that the restriction requirement is improper because the impact-resistant polystyrene recited in claim 1 was not taught or suggested by JP 54-120646, which was the basis for the examiner's holding that no special technical feature existed.

However, the impact-resistant polystyrene ingredient is an optional—i.e., non-essential—ingredient in claim 1. (Note the recitation, in the last line of claim 1 “0 to 50%” of this polystyrene.)

Accordingly, the Japanese reference's failure to recite it is not material to the patentability of the claims' common feature.

In addition, applicants argue that the multilayer film of Group II is not suggested by JP 54-120646, so that the special technical features of the film are proper for examination here, along with the claims of Groups V, VI, VII.

However, common feature in all of the claims as grouped is the sealant layer's blend, not the multilayer film of Group II.

Under PCT restriction practice, the examiner, and not applicants, determines both the claim groupings and the common feature among them. That feature is the potential “special technical feature” in the claims, until prior art is found that renders it unpatentable. When prior art teaches/suggests that common feature, no “special technical feature” exists and restriction is proper between the claims as grouped.

Applicants elected claims to the multilayer film—i.e., Group II—in their 05 May 2004 response. The office need not (re)consider the non-elected claims at this point.

Lastly, the argument, on page 9 of the 23 September 2004 response, that the allowability of claims to the product renders the process claims patentable is not germane here. The product claims have not been allowed.

***Rejection Withdrawn***

8. The 35 USC 112 rejection of claims 3 and 4 for indefiniteness has been overcome by the amendment to claim 3 in the 23 September 2004 response.

***Rejection Maintained***

9. The 35 USC 103 rejection of claims 3-4 as unpatentable over Miyamoto in view of applicants' admission and JP 54-120646 is maintained for reasons of record.

***Response to Arguments***

10. Applicant's arguments filed in the 23 September 2004 response have been fully considered but they are not persuasive.

The arguments will be addressed here in the order in which they were presented.

On page 7, applicants argue that the prior art fails to teach films in which the polyethylene (PE) and polyolefin-type (PO) polymer layers are "two distinct interlayers".

However, the PE and PO layers of applicants' films probably form one layer during the sealant films' production, so that no "distinctness" exists between them in the final sealant films. Note that:

a. Both of applicants' PE and PO ingredients may contain ethylene/butene copolymers, ethylene/vinyl acetate copolymers and/or ethylene/acrylate copolymers. Compare the paragraph bridging pages 6 and 7 of the specification and page 7, lines 19-26 thereof.

b. Applicants' so-called "distinct" layers are taught to be useful as one co-extruded film. See page 10, lines 10-12 of the specification.

Also, applicants are arguing a limitation that is not recited in the claims. That is, the claims do not call for "two distinct interlayers". See MPEP 2145(VI).

The examiner is not suggesting that the quoted phrase be added to the claims. Unless there is support for it in the specification, its recitation could be grounds for a new matter rejection.

Applicants presented no detailed arguments concerning the "alleged" admission or JP 54-120646. Therefore, they will not be discussed here.

#### ***Final Rejection***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Conclusion**

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S. M. Nolan-Rayford*  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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